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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,771	11/13/2001	Dennis J. Damico	IR-2972 (AA)	9623

7590

04/10/2003

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EXAMINER

KEEHAN, CHRISTOPHER M

ART UNIT

PAPER NUMBER

1712

4

DATE MAILED: 04/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/008,771

Applicant(s)

DAMICO ET AL.

Examiner

Christopher M. Keehan

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION***Specification***

The disclosure is objected to because of the following informalities: on page 2, sections 0005 and 0006, applicant states that in the working example of U.S. 5,385,990 the first and second components are mixed together in a **weight** ratio of 1:1.25. However, in this example, the first and second components are mixed together in a **volume** ratio of 1:1.25. In addition, on page 3, sections 0007 and 0008, applicant states that in the working example of U.S. 5,019,608 the first and second components are mixed together in a weight ratio of 1:1.25. However, in this example, the first and second components are mixed together in a weight ratio of 1:0.9. On page 15, in the table, the first column, the phrase "Generic name?" is present. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 11 recite the limitation "part A" and "part B" in these claims. There is insufficient antecedent

Art Unit: 1712

basis for this limitation in the claim. Parts A and B have not been defined prior in the claim.

In claim 7, the range of the liquid elastomer "at from 5% to 25% by weight, and said polyamide and/or polyamidoamine at from 10% to 30% by weight," if the lower limits are added, does not necessarily add up to the required at least 20% by weight in claim 1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 11-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Koshy (6,451,876). Koshy discloses a two-part dispenser comprising first and second containers adapted to dispense (col.10, lines 56-63). Regarding the claim language concerning the composition, it is not clear how the composition present inside the dispenser materially affects the overall claim dispenser. The claimed composition appears to be an intended use of the dispenser. The intended use of the claimed invention must result in a structural difference

Art Unit: 1712

between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11-18 are rejected under 35 U.S.C. 102(b) as being anticipated by *Abbey et al.* (5,385,990). *Abbey et al.* disclose a two-part dispenser comprising first and second containers adapted to dispense (col.10, line 58-col.11, line 17).

It is the examiner's position that for *Abbey et al.* to have prepare a first and second part of the adhesive, each component would have been in a separate container before mixing together, and by metering and mixing these containers had to have been adapted to dispense. Regarding the claim language concerning the composition, it is not clear how the composition present inside the dispenser materially affects the overall claim dispenser. The claimed composition appears to be an intended use of the dispenser. The intended use of the claimed invention must result in a structural difference between the

Art Unit: 1712

claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Allowable Subject Matter

Claims 1-10 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action. A reasonable search of the prior art of record failed to reveal the limitations as set forth in claim 1, specifically a sheet mold compound with a class A surface, with a substrate bonded to the backside thereof, with the adhesive composition as instantly claimed. Koshy (6,451,876 B1) discloses the instantly claimed components, but a volume:volume ratio of component A to B of 1.9:1 to about 2.7:1. This is in opposite proportions to that as instantly claimed. As noted in applicant's specification, Abbey et al. (5,385,990) discloses the instantly claimed components but in a volume ratio of 1:1.25. This is not included in the instantly claimed range, and applicant has shown favorable experimental results in the instantly claimed range.

Art Unit: 1712

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Keehan whose telephone number is (703) 305-2778. The examiner can normally be reached on Monday-Friday, from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Dawson can be reached on 308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Christopher Keehan *CME*

April 1, 2003



Robert Dawson
Supervisory Patent Examiner
Technology Center 1700